



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,209	05/15/2002	Hideki Hirano	1155-0245P	1052
2292	7590	06/16/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/088,209

Applicant(s)

HIRANO ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 18 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-8

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Jeffrey C. Mullis
J Mullis
Art Unit: 1711

ATTACHMENT TO ADVISORY ACTION

Applicants' arguments filed 5-18-04 have been fully considered but they are not deemed to be persuasive.

Applicants argue unexpected results. However as set out previously, applicants have provided no data comparative to the closest prior art. Comparative data must be with the closest prior art and not with other prior art, MPEP § 716. If applicants believe the Examiner is incorrect about this, applicants are requested to point out which embodiment the primary references (presumed by the Examiner to be the closest prior art) applicants' comparative data are reproducing.

Applicants argue that various references fail to disclose this feature or that feature of the claims. For instance applicants argue that "Kodama fails to teach the presence of a liquid ethylene/alphaolefin random copolymer". However it is not the position of the Examiner that any reference teaches all elements of applicants' composition, nor is it the position of the Examiner that any one of the references anticipate the claims. As applicants' data of their specification including that of for instance comparative Example 7 is not an embodiment of the closest prior art, it is immaterial that Examples 6 and 7 may exhibit superior results compared to comparative Example 7. It is applicants' burden to provide proof of unexpected results

Art Unit 1711

and as of yet no data probative of such results have been presented. As no such data has been presented, it is immaterial whether or not the Examiner is correct that applicants' "unexpected results" flow naturally from the references (in which case such results would not be unexpected even though improved).

Applicants argue that Hirano "attempts to solve a particular problem in a completely different way than applicants." However whether or not this is true is immaterial since it is not necessary that a reference be modified for the same reason as disclosed by an applicant's specification. Applicants allege that the term "one kind of resin" as disclosed by Hirano is meant to indicate that Hirano teaches that a mixture of "resin(s)" should not be used. However there is nothing in Hirano to indicate that the term "one kind of resin" is not merely a minimum requirement and that other of the resins may be present.

In fact, patentees refer to "one kind" of polar group in claim 2 of the patent and at column 2 lines 16-20 despite the fact that the term "at least one kind" polar group is disclosed at column 2 line 34. It is therefore clear that the term "one kind" as used by Hirano et al. is merely a minimum requirement where used in the patent. In any case the test for obviousness is what would occur to those of ordinary skill in the art when viewing the

Serial No. 10/088,209

-4-

Art Unit 1711

combination of references, not first one reference and then the other. The primary references disclose applicants' combination of materials (with the exception of the ethylene alphaolefin copolymer) and at the very least Hirano et al. does not disclose that a combination of resins will give poor results and therefore even if the term "only one kind of resin" appeared in Hirano et al. (such as does not occur) the combination of references would suggest this.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Jeffrey Mullis
Primary Examiner
Art Unit 1711

J. Mullis:cdc

June 11, 2004

